IN THE

Supreme Court of the United States

OCTOBER TERM, 1978

No. 78-826

ELLSWORTH H. MOSHER,
Petitioner

v.

HON. HOWARD T. MARKEY
HON. GILES S. RICH
HON. PHILLIP B. BALDWIN
HON. DONALD E. LANE
HON. JACK R. MILLER

The Chief Judge and the Associate Judges of the United States Court of Customs and Patent Appeals

and

CHIRANJIB K. SARKAR,
Respondents

BRIEF OF DR. C. K. SARKAR (SARKAR) IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI

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Respondent, Sarkar, files the following Brief in opposition to Respondents' Petition for a Writ of Certiorari.

STATEMENT OF THE CASE

Dr. C. K. Sarkar through his licensee, Tri-County Engineering Co. of Naples, Florida, filed a patent application several years ago in the United States Patent and Trademark Office (PTO). The application fully discloses this invention as is required by 35 U.S.C. 112. Certain valuable trade secrets of necessity, therefore, are disclosed. Like all other pending applications, the PTO continues to hold Sarkar's application in confidence under 35 U.S.C. 122.

The invention recited in the Sarkar application has been found by the PTO to be useful, novel and nonobvious. Indeed, it constitutes a major breakthrough in the technology to which it relates. Normally, such a finding by the PTO would result in the issuance of a patent. *Graham* v. *John Deere*, 383 U.S. 1, 15 L Ed 2d 545, 148 U.S.P.Q. 459 (1966).

The PTO, however, has refused to issue a patent on the grounds that the invention falls outside the scope of the statutory subject matter prescribed in 35 U.S.C. 101. *Gottschalk* v. *Benson*, 409 U.S. 63, 175 U.S.P.Q. 673 (1972); *Parker* v. *Flook*, 437 U.S. ——, 98 S. Ct. 2522, 198 U.S.P.Q. 193 (1978). The correctness of this position is the sole issue in Sarkar's appeal now before the Court of Customs and Patent Appeals (CCPA).

To protect his valuable and novel trade secrets from destruction when seeking his right of appeal (35 U.S.C. 142) on an issue of law fraught with controversy, Sarkar moved the CCPA upon initiation of his appeal to hold his case *in camera*. Based upon a finding of special facts and circumstances indigenous to the Sarkar case, the CCPA granted Sarkar's motion. *In re Sarkar*, 575 F. 2d 870, 197 U.S.P.Q. 788 (CCPA, 1978). The PTO, as the public's lawful defender and appellee in *Sarkar* chose not to seek review of the CCPA's decision.

In reliance upon the finalization of the CCPA's decision to hold the case *in camera*, Sarkar perfected his appeal, which of necessity meant making of record his trade secrets.

Thereafter, by third party proceeding of which Sarkar had no notice, Petitioner sought access to Sarkar's record and thus, his trade secrets. Access was refused by the CCPA. *In re Mosher*, 199 U.S.P.Q. 82 (CCPA, 1978).

Petitioner seeks a review by certiorari of *Mosher*, supra. and has, for the first time, named Sarkar as a party, thus attempting to now bring Sarkar's record before this Court.

ARGUMENT

Summary

The Petition for Writ of Certiorari should be denied because:

1) This case gives rise to no major issue of or conflict in the law, it being one decided on its specific facts.
2) The Petition is needless, premature and moot as to Sarkar's case.
3) The granting of the Petition could materially prejudice the public interest.
4) Petitioner's admissions render his Petition dismissable as to Sarkar's case.
5) A mere cursory review of the CCPA's decisions shows them to be correct and not in need of review.

REASONS FOR DENYING THE WRIT

This Case Gives Rise To No Major Issues of or Conflict In the Law, It Being One Decided On Its Specific Facts.

The decisions of the CCPA in *Sarkar*, and *Mosher*, supra., speak for themselves and are reprinted in the Petition at pg. 1-b et seq. The cases turn on the specific circumstances and facts indigenous to the *Sarkar* case. The CCPA merely invoked the classic, inherent and often used powers of any Article III Court. Its Rule 5.13(g) is merely a proper reflection of this inherent power. Federal courts for many years, for example, have protected trade secrets in patent litigation. Moore's *Federal Practice*, Vol. 4A pg. 34-110, § 34.19[2] fn 21-22.

Petitioner's attempt to raise the spector of major issues are nothing but false clouds. The openness of Federal Court records has never been absolute. If anything, Petitioner, rather than the CCPA, seeks to overturn "139 years" of this doctrine, recently affirmed not just in *Sarkar*, but in *Nixon* v. *Warner Communications, Inc.*, 46 U.S.L.W. 4320 (1978).

The public's interest at all times in the *Sarkar* case was fully represented by its lawful designate, the PTO. Within the constraints, then, of 35 U.S.C. 122, the public via its representative, the PTO, had full access to all files, records and proceedings—and fully participated therein. Fairness was always present and the protective order was no broader than needed to do substantial justice.

None of the reasons, expressed or implied, within Rule 19 of the Rules of the Supreme Court of the United States for granting certiorari are present in this case. The Petition should therefore be dismissed.

The Petition is Needless, Premature and Moot As To Sarkar's Case.

The CCPA is well advanced in deciding the *Sarkar* case on its merits. An oral hearing was held on October 5, 1978, almost a month and a half before this Petition was filed. Even assuming the correctness of Petitioner's erroneous legal contentions, he had no right other than to be a mere spectator at the hearing. Given the current backlog of the CCPA, a decision is imminent.

If the CCPA decides the *Sarkar* case in favor of Sarkar, and no review is sought by the PTO, the Sarkar patent will issue shortly thereafter, pending some totally unexpected circumstance. The issuance of the patent makes public the entire record, thus rendering the Petition moot.

If the CCPA's decision is adverse to Sarkar, or for some other reason the patent does not issue, Petitioner, who disavows any interest in Sarkar's subject matter (pet. pg. 5), can make no showing why he should be able to destroy Sarkar's valuable trade secrets by entrance into the case. 35 U.S.C. 122. Thus, no access to Sarkar's subject matter will be allowed anyway.

The Petition is therefore needless, premature and moot as to Sarkar's case.

As to Petitioner's generic attack on CCPA Rule 5.13(g) itself, under the *In re Mosher* case, supra., Sarkar is not a party thereto and has no standing to address the issues therein. The Petition, however, should be dismissed at least as to the *Sarkar* case.

The Granting of the Petition Could Materially Prejudice the Public Interest

The CCPA's decision in *Sarkar*, supra. enabled Sarkar to seek judicial review of an area of the law about which there is much need for clarification, by way of lower

court interpretation of the recent decisions of this Court in *Benson* and *Flook*, supra. The granting of this Petition would further deter others from seeking judicial review and thus, further clarification. Clearly, this is not in the public interest.

It is undeniable that if this Petition were granted as to the *Sarkar* case, the appellate process on the merits of Sarkar's application would have to stop. This delay could well cause the delay of the issuance of the patent and thus, the lawful dedication of the trade secret rights to the public by disclosure. *Kewanee Oil Corp.* v. *Bicron Corp.*, 416 U.S. 470, 181 U.S.P.Q. 673 (1974). Progress in the useful arts would be hindered. Such is clearly not in the public interest (Art. I, Sect. 8, U.S. Const.).

Furthermore, if this Petition were granted, the CCPA record would be sent to the U.S. Supreme Court. This, in turn, would necessitate Sarkar's filing a motion for this Court to hear the case *in camera*. A further delay will then occur while this Court considers whether it has the power to do what the CCPA did. Again, the public interest is hurt.

In addition, the effect that a granting of this Petition would have on current appellate practice would be significant and detrimental to the public interest. The mere granting of this Petition, it is respectfully submitted would give rise to a question as to whether any non-party, third person (such as Petitioner) could usurp the function of the PTO and collaterally attack, by mere petition, any decision of the CCPA. A flood of petitions could deluge the CCPA. Inventors having valuable trade secrets would be reluctant to file applications and thus, anti-social behavior encouraged. *Kewanee*, supra. The CCPA's processes could be slowed to a crawl awaiting the outcome of this Court's ultimate decision before deciding any other petition filed. Cases already decided would be thrown open at any time to outside collateral attack, and

the uncertainty of the strength of issued patents thrown into further doubt. No public interest would be served by granting this petition.

It is also respectfully submitted that the prejudice to *Sarkar* if the petition were granted would be unwarranted and not in the public interest. Sarkar is a member of the public. He seeks to give to other members of the public, through the patent system, something they clearly did not have before Sarkar invented it. The granting of this petition with its eventual delay and cost to Sarkar who relied upon the due process offered him by the PTO and CCPA, would not be just or fair to him and thus to the public.

Petitioner's Admissions Render His Petition Dismissable As To Sarkar's Case

Petitioner is admittedly, a practicing patent attorney and partner in a law firm in Washington, D.C. which represents many corporate clients who could conceivably stand to benefit materially from a destruction of Sarkar's trade secret rights. Petitioner tacitly admits that he does not know the subject matter of Sarkar's application for if he did, his case would be moot.

Petitioner admits on pg. 5 of the Petition that he "has no interest (commercial or otherwise) in the particular subject matter involved in Sarkar's appeal". Simultaneously, he joins Sarkar as a Respondent so that Petitioner may have access to Sarkar's trade secrets if he wins his case in this Court.

If Petitioner has no interest in Sarkar's file, his attack is merely a generic one on the *Mosher* decision and thus raises issues only as to the future handling of cases after Sarkar's. Since Sarkar is not involved, the Petition should be dismissed as to *Sarkar's* case.

It is to be pointed out that Sarkar was clearly denied due process by Petitioner's admitted failure to serve his CCPA papers on Sarkar. Petitioner's excuse for this failure (pet. 3-c) is feeble, since he was able to serve this Petition on Sarkar's attorney of record.

By his own admissions then, the *Sarkar* case is not a part of Petitioner's alleged cause, case or controversy and his petition to the extent it seeks access to Sarkar's record should be dismissed.

A Mere Cursory Review of the CCPA's Decisions Shows Them To Be Correct and Not In Need of Review

The decisions in *Sarkar* and *Mosher*, supra. are short, clear, and correct—a fact evident from a mere cursory review thereof. Petitioner, whose standing is anything but clear, constitutes nothing more than a single member of the public seeking to usurp a function of the public's duly appointed representative, the PTO. In this case, there is not one scintilla of evidence, nor any allegation that the PTO did not fully and honorably uphold its full duty to the public. On behalf of the public it chose not to seek review. In reliance thereon, the CCPA, the PTO and Sarkar went forward in good faith with Sarkar's appeal. It would ill-behoove this Court to open itself up to a flood of petitions by anyone who may collaterally seek to question, not just the CCPA, but the PTO as well, and who could destroy valuable property rights without due notice, in the process.

CONCLUSION

The Petition for Writ of Certiorari should be dismissed.

Respectfully submitted,

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